

III. REMARKS

The prosecution of this application has been reopened after the filing of an appeal. This is a response to the first Office Action issued upon the reopening of the prosecution.

In the Office Action, claims 10-11, 18-19, 21-22, 27, 31, 35 and 39 were said to have allowable subject matter, but were objected to on the basis of dependency from a rejected base claim.

Claims 1-40 were rejected on the basis of double patenting, as set forth in Point 3 of the Office Action. With respect to the filing of a terminal disclaimer, Applicant prefers to wait until a final wording of the claims has been established before submitting the terminal disclaimer.

Claims 1, 7-9, 12-13, 20 and 23-26, 29-30, 33-34, and 37-38 were rejected under 35 U.S.C. 103 as being unpatentable over Mizikovsky (US 5,559,860) in view of Kang (US 5,058,150) for reasons set forth in the Action. Claims 3-5, 28, 32, 36 and 40 were rejected under 35 U.S.C. 103 as being unpatentable over Mizikovsky in view of Kang and Bremer (US 6,018,671) for reasons set forth in the Action. Other ones of the claims were also rejected under 35 U.S.C. 103 as being unpatentable over various combinations of the cited art, namely, claim 14 over Mizikovsky in view of Kang and Villa-Real (US 4,481,382), and claims 15-17 over Mizikovsky in view of Kang and Wolff (US 5,327,486) for reasons set forth in the Action.

A typographical error in claim 37 has been corrected.

With respect to the rejections under 35 U.S.C. 103, the examiner notes (middle of page 6 of the Action) that Mizikovsky does not explicitly teach that the portable device sends the reply and provides a selected response to the caller exclusively through the action of the portable terminal, and also does not teach that a selected accessory device is integrated into the mobile device. The examiner then combines the teachings of

Mizikovsky with Kang to show that a telephone answering machine is integrated into a radio-telephone.

Various ones of the independent claims, namely claims 1, 20 and 23, are amended and the following argument is presented to distinguish the claimed subject matter from the teachings of the cited art, considered individually and in combination, thereby to overcome the rejections under 35 U.S.C. 103 and to show the presence of allowable subject matter in the claims.

Concerning the cited references, it is urged that Kang only discloses that a "car phone" may comprise a built-in electronic answering machine, which is capable of both responding to an incoming call with a voice-synthesized response message and electronically recording a voice message left by the caller.

With respect to the rejections under 35 U.S.C. 103, there is no motivation to combine the references Mizikovsky with Kang because of their teachings diverge from an accomplishment of the purposes of the presently claimed subject matter. As noted in the MPEP 2143.01: The proper inquiry is whether there is something in the prior art as a whole to suggest the desirability of the presently claimed subject matter to obtain an indication of obviousness. The fact that the references can be combined or modified is not sufficient to establish obviousness. Although a prior-art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so, in order to indicate obviousness.

The foregoing test for obviousness is not met by the attempted combination of Kang with Mizikovsky. Differences between Kang and the presently claimed subject matter are the following:

1. A car phone is not a portable terminal in the sense that it can be carried about readily in person's pocket as is the case with a cell phone. At the time of filing Kang

(May 1989) a car phone (or a "vehicle radio-telephone" as Kang calls it in column 1, line 8) was still too heavy to be carried around, and Kang explains that the voice messaging functions are implemented on an "option board" (i.e. a separate circuit board that can be installed in the device), as taught in column 4, last three lines.

2. The reply that the Kang's car phone sends to an incoming call does not have a form selectable from a plurality of forms of communication, because the reply is always a voice message played back during the telephone connection. The present claims require the feature of a selectable form of communication.

3. Kang's car phone does not identify the caller, because the voice message has to separately ask the caller to key in his number with DTMF (dual tone multi-frequency) signals, which Kang's phone stores but does not use for caller identification. The present claims require the feature that identification of the caller is accomplished by the portable terminal.

Therefore, upon viewing the teachings of Mizikovsky and Kang in terms of accomplishing the goals of their respective inventions, there is no indication or direction for one to combine their teachings in an attempt to develop the presently claimed subject matter.

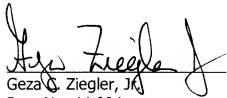
If one considered combining Kang with Mizikovsky, the most one would get is a telephone terminal that firstly should be large enough to accommodate auxiliary circuit boards (note that Mizikovsky's mobile terminal does not include any voice messaging functions, so the only way in which they would come into play would be in the form taught by Kang). The resultant device would not be a portable terminal, and would not have the feature of selectable forms of response provided by the portable terminal exclusively without separate auxiliary devices.

To emphasize the foregoing features of the invention, which distinguish the presently claimed subject matter from the cited art, considered individually and in combination, each of the independent claims 1 and 20 is amended to include, at the end of the claim, the limitation, "... irrespective of which of said plurality of forms of communication is employed in the selected response". A corresponding amendment is made to independent claim 23.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for the two month extension of time (\$450) as well as any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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25 June 2007
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